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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/910,354

07/20/2001

Kevin A. Jarrell

2003320-0032

2372

24280 7590 01/17/2007  
CHOATE, HALL & STEWART LLP  
TWO INTERNATIONAL PLACE  
BOSTON, MA 02110

EXAMINER

VOGEL, NANCY S

ART UNIT

PAPER NUMBER

1636

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

01/17/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

09/910,354

Applicant(s)

JARRELL ET AL.

Examiner

Nancy T. Vogel

Art Unit

1636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 12-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 12-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date See Continuation Sheet.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :11/16/05, 11/9/05, 3/23/06, 5/15/06

### **DETAILED ACTION**

Claims 1-5, 12-21 are pending in the case.

The claims under examination are those submitted on 11/23/05.

Receipt of Information Disclosure Statements on 5/15/06, 3/23/06, 11/16/05, 11/9/05, and 11/23/05 is acknowledged. Citations of references which were not received, listed on the Information Disclosure Statements of 3/23/06 and 5/15/06 are struck through. Citations listed on the Information Disclosure Statement of 11/9/05 are duplicates of references already cited, and have been struck through.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action

### ***Specification***

The amendment filed 11/23/05 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Changes have been made at pages 34 and 35 which constitute new matter, which do not appear to be typographical errors, but rather, are substantial in nature. These alterations constitute new matter.

Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Rejections - 35 USC § 102.***

Claims 1, 2, 4, 5, 12, 14-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Harney et al. (US Patent US Patent 6,495,318) (previously cited).

This rejection is maintained essentially for the reasons made of record in the previous Office action, mailed 5/19/05. Applicant's arguments filed 11/23/05 have been considered, but have not been found convincing.

Applicants have argued that since the claims have been amended, the reference no longer is applicable and the rejection should be withdrawn. However, it is maintained that the recitation of "vector detection elements" would be reasonable interpreted to include such elements as a restriction site, since particular DNA elements, including vectors, may be detected by the presence of particular restriction enzyme sites. The specification does not specifically define "vector detection elements" in such a way that would exclude this interpretation. Therefore, it is maintained that the reference discloses the claimed invention and the rejection is maintained.

***Claim Rejections - 35 USC § 103***

Claims 1-5, 12-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harney in view of Jarrell (US Patent 5,498,531, "Jarrell '531") or Jarrell (US Patent 5,780,272 "Jarrell '272").

This rejection is maintained essentially for the reasons made of record in the previous Office action, mailed 5/19/05. Applicant's arguments of 11/23/05 have been considered, but have not been found convincing.

Applicants have argued that since Harney do not disclose the subject matter of claim 1, the additional citation of Jarell '531 and Jarrell '272 does not render the claimed invention obvious. However, as is set forth above, it is maintained that Harney do disclose the recited invention, since a restriction enzyme site may be considered to be encompassed by the recitation of "vector detection elements", and therefore, the rejection is maintained. Applicants have further argued that just because the references can be combined, does not render the invention obvious unless there is a suggestion in the art to do so. However, In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In this case, the Jarell references clearly disclose nucleic acids that have added intronic elements to at least two of the nucleic acids, such that trans-splicing can take place between them in order to efficiently manipulate nucleic acids by specific cleavage and ligation (see column 2, line 33- column 3, line 40 of Jarrell '531, and col. 2, line 39 – col. 3, line 45 of Jerrell '272). The teaching is generally applicable to any method of manipulating nucleic acids, and therefore one would have been motivated to modify the primary reference using the teachings of Jerrell '531 and '272 in order to obtain the disclosed benefits of ease of manipulation of said nucleic acids, including joining said nucleic acids and eliminating non-essential regions. Therefore, the rejection is maintained.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

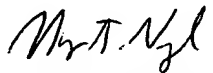
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nancy T. Vogel whose telephone number is (571) 272-0780. The examiner can normally be reached on 6:30 - 3:00, Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Irem Yucel, Ph.D. can be reached on (571) 272-0781. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1636

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

12/05/06

  
NANCY VOGEL  
PRIMARY EXAMINER